

U.S. Application No. 10/808,568
Inventor: Vincent DE LAFORCADE
Attorney Docket No.: 05725.0918-01
Reply to Office Action dated April 30, 2008

In purported support of the restriction requirement, the Office Action asserts that the two groups of claims are distinct because they "are related as subcombinations disclosed as usable together in a single combination." Office Action at 3. The Office Action further asserts that "the inventions have acquired a separate status in the art in view of their different classification . . . [and] due to their [purportedly] recognized divergent subject matter; . . . [they] require a different field of search; . . . prior art applicable to one invention would not likely be applicable to another invention; [and] the inventions are likely to raise different non-prior art issues under 35 U.S.C. § 101 and/or 35 U.S.C. 112, first paragraph." Id. at 3-4.

As an initial matter, Applicant respectfully notes that in Applicant's Supplemental Response to Restriction and Election of Species Requirements filed October 15, 2007 ("previous Response"), Applicant identified in written remarks a number of reasons why the restriction and election of species requirements included in the Office Action of May 29, 2007 ("the previous Office Action"), were clearly improper. In spite of those reasons, the current Office Action has maintained the previous Office Action's improper restriction and election of species requirements. Moreover, rather than responding substantively to any of those written remarks, the current Office Action has merely asserted, in a completely unsupported manner, that the written remarks are not persuasive. See Office Action at 2. This failure to address Applicant's remarks is clearly contrary to USPTO rules of practice. As a result, the current Office Action has improperly withdrawn non-elected claims 40-95 and 169-224 from further consideration. Applicant continues to respectfully request reconsideration and withdrawal of the restriction and election of species requirements included in the previous Office Action

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for at least the reasons outlined in Applicant's previous response. If the Examiner continues to maintain the previous restriction and election of species requirements, Applicant respectfully requests that the Examiner respond to Applicant's remarks and provide a purported rationale for maintaining such requirements rather than merely making them final without providing Applicant with any explanation.

If the Examiner maintains the previous improper requirements and the restriction requirement included in the current Office Action, Applicant respectfully traverses the current restriction requirement. Applicant respectfully submits the current restriction requirement is also improper for a number of reasons. First, the Office Action has not provided any rationale in purported support of the allegation that the two groups of claims are related as "subcombinations usable together." Indeed, Applicant respectfully notes that all of the claims pending in the application recite methods, and subcombinations are generally associated with apparatus claims rather than method claims. Moreover, according to USPTO rules of practice, a restriction requirement based on an allegation that two or more groups of claims are related as "subcombinations usable together" is only proper "when there would be a serious burden if restriction were not required, as evidenced by separate classification, status, or field of search." M.P.E.P. § 806.05(d). Contrary to the Office Action's assertions, the alleged groups of claims do not have a separate classification, as conceded by the Office Action, which acknowledges that both groups of claims are classified in the same class and subclass. See Office Action at 3. Further, the Office Action has also failed to provide any rationale in purported support of the assertion that the two alleged groups of claims relate to recognized divergent subject matter. Indeed, the Examiner's

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acknowledgement that the claim groups are classified in the same class and subclass is evidence that the alleged groups are not recognized divergent subject matter.

Moreover, although the Office Action asserts that the two alleged groups of claims will require a different field of search, the Office Action has provided no evidence in purported support of this allegation. Again, classification in the same class and subclass is evidence that the two alleged groups of claims would require the same field of search. For at least these reasons, Applicant respectfully submits that the restriction requirement is improper and requests reconsideration and withdrawal of the requirement.

In order to fully comply with the Office Action's requirement to elect a single Group of claims for examination, Applicant provisionally elects, with traverse, Group II, claims 54-89 and 183-218.

The Office Action contains a number of characterizations of the disclosure and the claims with which Applicant does not necessarily agree. Unless expressly noted otherwise, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

The Examiner is cordially invited to call Applicant's undersigned attorney at (404) 653-6559 if a telephone conversation would expedite the prosecution of the above-referenced application.

U.S. Application No. 10/808,588
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If there is any fee due in connection with the filing of this Response, please
charge the fee to our Deposit Account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: June 30, 2008

By: 

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